

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

### **REMARKS**

By the present response, Applicant has amended claims 1-3, 5, 6, 8, 10, 11, 15, 16 and 18 to further clarify the invention. Claims 1-18 are pending in this application. Reconsideration and withdrawal of the outstanding rejections and allowance of the present application are respectfully requested in view of the above amendments and the following remarks.

In the Office Action, claims 1, 7, 11 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,904,610 (Bayrakeri et al.) in view of U.S. Patent No. 5,805,763 (Lawler et al.) and further in view of U.S. Patent No. 6,018,372 (Etheredge) and U.S. Patent No. 5,831,663 (Waterhouse et al.). Claims 2 and 3 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., U.S. Patent No. 5,734,853 (Hendricks et al.), and U.S. Patent No. 6,101,180 (Donahue et al.). Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Hendricks et al., Donahue et al. and U.S. Patent No. 6,314,572 (La Rocca et al.). Claims 4, 14, 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., and U.S. Patent No. 6,169,543 (Wehmeyer et al.). Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Hendricks et al., Donahue et al. and U.S. Patent No. 5,861,906 (Dunn et al.).

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al. and further in view of Etheredge, Waterhouse and Dunn et al. Claims 8 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Dunn et al., Etheredge and Waterhouse et al. Claim 13 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al. and Hendricks. Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Dunn et al. and LaRocca et al. Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Dunn et al. and Etheredge.

#### 35 U.S.C. §103 Rejections

Claims 1, 7, 11 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge and Waterhouse et al. Applicant has discussed the deficiencies of Bayrakeri et al and Waterhouse et al. in Applicant's previously filed response and reassert all arguments in submitted in that response. Applicant respectfully traverses these rejections and provides the following additional remarks.

Lawler et al. discloses a program recording system to allow a user of an interactive viewing system to record a pre-selected program. The interactive viewing system includes at least one program guide that shows the user selection of a program for recording. In response

to the user selection, the system sets a record tag that is associated with the selected program and identifies the selected program for recording. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the selected program.

Etheredge discloses an electronic programming guide that allows a television receiver to access and interact with television viewing information. The electronic programming guide provides the viewer with a grid which lists channels, titles and show times. One format for presenting the grid shows an entire week of programming. Each row contains a show that is to be broadcast one or more times during the week. The first column lists the name of the show and the second column indicates the length of the show. The next seven columns represent the days of the week. For each time that the show is to be broadcast, the show time and channel are displayed in the appropriate column. The grid can be sorted many ways including by title, category, actors, or search terms.

Appellants assert that the Examiner has used impermissible hindsight in making the rejections. The Federal Circuit has forbidden the use of hindsight in the selection of references that comprise the case of obviousness. See, In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Moreover, as the Federal Circuit has stated in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at pages 1457 and 1458:

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if

not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, the court has required the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicant respectfully submits that the Office Action relies on impermissible hindsight as there is no suggestion in the prior art for the features and/or combinations. That is, it is well-founded that when a rejection depends on a combination of prior art references, there must be some teachings, suggestion, or motivation to combine the references. See ACH Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and In re Geiger, 815 F.2d, 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Applicant believes that there is no teaching, suggestion, or motivation to combine the references and the rejection

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

of all the claims should be withdrawn at least for this reason. Applicant further believes that the Office Action relies on impermissible hindsight to combine the features of the applied references (as well as the “non-applied references”). That is, there is no suggestion in the references to make the combination. Rather, the only motivation is provided in Applicant’s own specification. The Examiner can not use Applicant’s own specification as a “road map” to find the claimed features. As stated in In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991), the references themselves must provide some teaching whereby the Applicant’s combination would have been obvious. The Office Action therefore relies on impermissible hindsight. The applied references do not contain any teaching whereby the claimed features would have been obvious. Additionally, the Office Action clearly relies on a piecemeal reconstruction of the prior art in order to find claimed features. In view of this, the combination and rejections are improper and should be withdrawn.

Regarding claims 1 and 11, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of these claims of, *inter alia*, transmitting environmental information selected by the viewer using an initial menu along with a server address and a viewer’s ID number to the server from the TV. The Examiner admits that Bayrakeri et al. does not disclose or suggest environmental information adjustments related to broadcast information settings, but asserts that these limitations are disclosed in Lawler at col. 13, lines 18-23. However, these

portions merely disclose that an interactive station controller could periodically poll the headend to determine whether a record tag has been set for a program, and then control the recording device to record the associated program. This is not transmitting a download request of environment information inputted by the viewer from the TV to the server and transmitting the environmental information corresponding to the request from the server to the TV, as recited in the claims of the present application. Lawler et al. merely relates to selecting programs to be recorded. This is not environmental information comprising channel settings, and broadcast reservation settings, as recited in the claims of the present application.

Further, the Examiner asserts that Bayrakeri teaches that the custom-IPG is stored for the viewer at the head end. However, the Examiner appears to misunderstand the Bayrakeri reference. Bayrakeri teaches that a user interface contains program guide information, i.e., the interface forms an interactive program guide for television systems, and that this program guide is created entirely in the head end of the information distribution system, and transmitted to the user's STT for decoding and display, and an OSD graphics layer is either stored in the STT or transmitted with the user interface to facilitate a mask and reveal function that provides a technique to highlight, mask or otherwise identify objects within the user interface (see, col. 6, line 59-Col. 7, line 2). Simply, Bayrakeri discloses the head end containing the program guide, wherein the program guide is not inputted or stored by the user. The user merely manipulates user interface of the program guide. In contrast, in embodiments according to the present

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

invention, the viewer selects an initial menu along with a server address and a viewer's ID number, and the selected environmental information is transmitted to the server form TV. In the next time, the environmental information is stored in the server. If the viewer can connect TV to the server, the viewer can download the environmental information stored in the server. Bayrakeri does not disclose or suggest these limitations in the claims of the present application.

Moreover, one of ordinary skill in the art would have no motivation to combine Lawler with Bayrakeri et al. The Examiner asserts that motivation is found in col. 2, lines 8-13 of Lawler and states that using the program reservation functions/device of Lawler for the purpose of notifying the recording device at the user end to record a program when it is available provides motivation. However, the limitations in the claims of the present application do not disclose a recording device or notifying a recording device to record a program. Therefore, these features of Lawler et al. provide no motivation and no suggestion to combine Lawler et al. with Bayrakeri et al. A reference must contain some suggestion to combine the reference with another reference. There is no suggestion for combination with Bayakeri found in Lawler. Thus one of ordinary skill in the art would have no motivation to combine these references.

The Examiner admits that neither Bayrakeri et al., Lawler et al. nor Etheredge disclose or suggest the method occurring inside a TV, but again asserts that the Waterhouse et al. reference discloses these limitations. However, as noted in Applicant's previously filed response, Waterhouse et al. merely relates to a television receiving control codes for channel selection. In

this regard, the TV acts as a passive device. In contrast, the limitations in the claims of the present application relate to a TV transmitting environmental information to a server, as well as transmitting a download request of environmental information to the server, and then receiving the environmental information transmitted from the server in response to the download request. Waterhouse et al. does not disclose or suggest these limitations in the claims of the present application.

In addition, the Examiner asserts that one of ordinary skill in the art would be motivated to combine Waterhouse et al. with the other cited references for the purpose of not needing a separate supply voltage to power the microprocessor in the set top box. This is not valid motivation for one of ordinary skill in the art to combine these references in an attempt to achieve the limitations in the claims of the present application. This asserted purpose in Waterhouse provides no suggestion or motivation for the combination of these references. This is an improper combination as no proper motivation exists for this combination.

Further, in another part of the Office Action on page 10, the Examiner admits that neither Bayrakeri, Lawler, Waterhouse, or Etheredge disclose or suggest transmitting a TV address, a server address, a viewer ID number, and viewer selection environment information from the TV to the server, but asserts that Hendricks discloses transmitting a TV address in Fig. 4B element 924, col. 17, lines 54-55, col. 18, lines 19-23, and discloses transmitting an ID number in Fig. 4B element 928, and col. 17, lines 58-60. However, the Examiner has



Serial No. 09/930,441

Docket No. HI-0042

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

misunderstood the Hendricks reference. Hendricks discloses information being stored a the set top box including an address field line 24 designating an address for the set top terminal, and a set top terminal identifier line 28 identifying each set top terminal. This information is stored at the set top terminal and is retrieved by the cable head end polling the set top terminal. Thus, the cable head end uses a polling request message and sends this message to each set top terminal to interrogate and gather the information. This is not transmitting from the TV to the server, a server address and a viewer's ID number, as recited in the claims of the present application. The set top box merely stores the information. Further, the set top terminal identifier 928 is not a viewer's ID number, as recited in the claims of the present application.

The Examiner further asserts that Donahue discloses transmitting a server address from a TV to the server, at col. 7, lines 6-10. However, these portions merely disclose that a router receives an input packet of information to examine its source and destination address and determines the optimal output port for the message. This is not transmitting a server address from a TV to a server along with environmental information selected by a viewer, as recited in the claims of the present application. These portions of Donahue et al. merely detail the function of a router. This has nothing to do with the limitations in the claims of the present application.

Moreover, one of ordinary skill in the art would have no motivation to combine Donahue with the other asserted references. The Examiner asserts that motivation is found in

Donahue for the purpose of determining the next path to take based on the source and destination address. However, determining a next path has no relation to the limitations in the claims of the present application. One of ordinary skill in the art would have no motivation to combine Donahue et al. that relates to multicasting digital data to a user accessing a Internet connection, with the other asserted references that relate generally to set top terminals and cable television distribution systems. There is no suggestion or motivation found in Donahue for combination with the other references and, therefore, this is an improper combination.

Regarding claims 7 and 12, Applicant submits that these claims are dependent on one of independent claims 1 and 11 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 1, 7, 11 and 12 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claims 2 and 3 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Hendricks et al., and Donahue et al. Applicant respectfully traverses these rejections and submits that these claims are dependent on independent claim 1 and, therefore, are patentable at least for the same reasons noted previously regarding this independent claim.

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claims of 2 and 3 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Hendricks et al., Donahue et al. and La Rocca et al. Applicant respectfully traverses this rejection and submits that claim 5 is dependent on independent claim 1 and, therefore, is patentable at least for the same reasons noted previously regarding this independent claim.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claim 5 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claims 4, 14, 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., and Wehmeyer et al.

Regarding claim 16, Applicant submits that this claim is patentable over the cited references for the same reasons noted previously regarding claims 1 and 11.

Regarding claims 4, 14 and 17, Applicant submits that these claims are dependent on one of independent claims 1, 11 and 16 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 4, 14, 16 and 17 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Hendricks et al., Donahue et al and Dunn et al. Applicant respectfully traverses this rejection and submits that this claim is dependent on independent claim 1 and, therefore, is patentable at least for the same reasons noted previously regarding this independent claim.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claim 6 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al. and further in view of Etheredge, Waterhouse and Dunn et al. Applicant respectfully traverses this rejection and submits that this claim is dependent on

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

independent claim 8 and, therefore, is patentable at least for the same reasons noted below regarding this independent claim.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claim 9 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claims 8 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Dunn et al., Etheredge and Waterhouse et al. Applicant submits that these claims are patentable over the cited references for the same reasons noted previously regarding claims 1 and 11.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 8 and 10 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claim 13 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al. and Hendricks. Applicant respectfully traverses this rejection and submits that this claim is dependent on independent claim 11 and, therefore, is patentable at least for the same reasons noted previously regarding this independent claim.

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claim 13 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Etheredge, Waterhouse et al., Dunn et al. and LaRocca et al. Applicant respectfully traverses this rejection and submits that this claim is dependent on independent claim 11 and, therefore, is patentable at least for the same reasons noted previously regarding this independent claim.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of claim 15 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayrakeri et al. in view of Lawler et al., Dunn et al. and Etheredge. Applicant submits that these claims are patentable over the cited references for the same reasons noted previously regarding claims 1 and 11.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of

Serial No. **09/930,441**

Docket No. **HI-0042**

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

claim 18 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Serial No. 09/930,441

Docket No. HI-0042

Amdt. dated October 11, 2006

Reply to Office Action of July 13, 2006

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that claims 1-18 are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Frederick D. Bailey, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
FLESHNER & KIM, LLP



Daniel Y.J. Kim  
Registration No. 36,186  
Frederick D. Bailey  
Registration No. 42,282

P.O. Box 221200  
Chantilly, Virginia 20153-1200  
(703) 766-3701 DYK/FDB:tlg

**Date: October 11, 2006**

\\Fk4\Documents\2019\2019-004\100213.doc

**Please direct all correspondence to Customer Number 34610**